

REMARKS

The filing of the accompanying Request for Continued Examination and this Preliminary Amendment & Response is a full and timely response to the outstanding Final Office Action mailed February 14, 2005. Upon entry of the amendments indicated above, claims 1 - 14 and 16 - 23 remain pending. Specifically, Applicants amended claim 16 to depend on independent claim 11 (which has been allowed), rather than previously-canceled claim 15. Applicants also amended independent claim 19 and dependent claim 23 to refer to first and second structures of the t-top. No new matter has been added. Applicants respectfully request that the application and presently-pending claims be reconsidered and allowed.

I. Revocation of Power of Attorney, New Power of Attorney & Change of Correspondence

Applicants submit herewith a Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address. Accordingly, please note the new correspondence address and the new Attorney Docket No. (50001/23006) for future correspondence in the present application.

II. Allowable Subject Matter: Claims 1 – 14 and 16 – 18

Applicants acknowledge with appreciation the indication in the Final Office Action that (in addition to previously-allowed claims 1 – 10) claims 11 – 14, 17 and 18 are also allowable. Applicants also note that claim 16 has been amended to address the rejection under 35 U.S.C. §112, ¶2 by correcting the dependency from a canceled claim. Claim 16 now depends from an allowable base claim and, therefore, is also allowable. As detailed below, however, Applicants respectfully submit that claims 19 – 23 are also patentable over the

cited art. Therefore, Applicants are filing the accompanying Request for Continued Examination.

III. Claims 19 - 23 are Patentable

The Final Office Action rejects claims 19 - 23 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Application Serial No. 2003/0089294 by Biemiller (“the ‘294 application”) in view of the U.S. Patent No. 4,901,899 to Barrett (“the ‘899 patent”).

A. Rejection of Claims 19 – 23 under 35 U.S.C. §103 is Legally Deficient

As an initial procedural matter, Applicants respectfully submit that the §103 rejection is legally deficient because the legal basis/rationale for the rejection is not apparent from the Office Action. Specifically, Applicants cannot determine whether the basis for the obviousness rejection relies on (1) a theory of an obvious modification of the ‘294 application and an assertion of official notice for the missing features or (2) a theory of an obvious combination of the ‘294 application and the ‘899 patent. The Office Action states that “[c]laims 19 – 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over [the ‘294 application in view of [the ‘899 patent]” -- apparently rejecting the claims based on a theory of an obvious combination. The explanation of the rejection, however, appears to rely on a theory of obvious modification. The Office Action further states:

[The ‘294 application] discloses a storage device for removably attaching to a t-top on a boat including a frame comprising marine fabric; an access flap 40 and a plurality of straps for securing the storage device to the t-top. The straps are secured to the top of the storage device. To merely secure the straps to the bottom of the storage device would have been a matter of design choice to one of ordinary skill in the art. Although the arrangement in [the ‘294 application] shows the straps on top of the storage device, it is obvious that more support would be provided [sic] with the straps on the bottom of the storage device.

In this regard, the Office Action acknowledges that the '294 application does not disclose, teach, or suggest the features recited in claims 19 – 23 of “a plurality straps attached to the bottom portion of the frame for providing support from underneath the frame when it is attached to a t-top on a boat.” The Office Action does not allege that the '899 patent corrects this deficiency by teaching these features. Furthermore, the Office Action does not allege any suggestion or motivation to combine the '294 application and the '899 patent in the manner.

Applicants note that the Office Action merely uses the '899 patent for the teaching of “D-Rings in combination with straps for securing the storage device” to apparently address the patentability of dependent claim 23 -- not claims 19 – 22. Even on the issue of the patentability of dependent claim 23, Applicants note that the '899 patent does NOT disclose, teach, or suggest “D-Rings in combination with straps” as alleged in the Office Action. The '899 patent discloses a foldable organizer or equipment carrier, in which D-rings 54, 56, 60, 62, 64, and 66 are used in combination with corresponding spring clips 57 and 59 -- *not straps*. The D-rings and the spring clips are used to secure the organizer in the folded arrangement to enable a user to carry the organizer. See Col 6, ll. 25 – 34.

Applicants respectfully submit that the '899 patent does not disclose, teach, or suggest *D-rings in combination with straps* for the purpose securing the device to a structure. Furthermore, Applicants note that the Office Action has not even established the requisite suggestion or motivation for combining the '294 application and the '899 patent. Even assuming for the sake of argument that the Office Action has established a proper suggestion or motivation to combine the references (which it has not), Applicants note that the '899 patent only discloses a single D-ring for engaging a single spring clip. In contrast, dependent claim 23 recites “a first *pair of D-rings* attached to the first end of one of the plurality of

straps for attaching the storage device to the first structure.” Therefore, the D-ring arrangement of the ‘899 patent CANNOT operate in the manner suggested by the Examiner to secure the storage device to the structure. The ‘899 patent requires a single D-ring to engage with a corresponding spring clip. Even if the foldable organizer of the ‘899 patent were modified to use a pair of D-rings (rather than a single D-ring) to engage with a single spring clip, it would be for purposes of redundancy, in the event the other D-ring failed. It would not be for the purpose of attaching the foldable organizer to another structure, but for the purpose of attaching the device to itself to product a folded arrangement for transport.

For this additional reason, Applicants respectfully submit that dependent claim 23 is patentable over the ‘294 application and the ‘899 patent. Accordingly, Applicants respectfully request that dependent claim 23 be allowed.

In view of the ambiguous nature of the legal basis/rationale for the rejection of claims 19 – 23, Applicants respectfully submit that they have not had the legally-prescribed opportunity to respond to this rejection. For this reason alone, Applicants respectfully submit that, if another rejection of these claims follows this RCE, it cannot legally be made a final rejection. Furthermore, Applicants specifically request that the next Office Action include a clarification of the statutory basis/rationale for the rejection of each of claims 19 – 23 under §103.

Despite the legal deficiency of the §103 rejection and in an effort to expedite allowance of the disputed claims 19 – 23, Applicants traverse both obviousness theories below.

B. Claims 19 – 23 are Patentable Under a Theory of Obvious Combination of the ‘294 Application and the ‘899 Patent

As detailed in Applicants’ prior response submitted January 10, 2005, a rejection of claims 19 – 23 under a theory of an obvious combination of the ‘294 application and the ‘899 patent is improper for at least the reason that the Office Action (both the first Office Action dated August 31, 2004 and the outstanding Final Office Action) fails to establish a proper suggestion or motivation to combine the references. Even assuming for the sake of argument that a proper suggestion or motivation to combine has been established (which Applicants do not concede), the ‘899 patent does not teach the features of “a plurality of straps attached to the bottom portion of the frame for providing support from underneath the frame” -- which the Office Action acknowledges is not disclosed in the ‘294 application. Therefore, Applicants respectfully submit that claims 19 – 23 are patentable over the ‘294 application in view of the ‘899 patent.

C. Claims 19 – 23 are Patentable Under a Theory of Obvious Modification of the ‘294 Application – Official Notice is NOT Proper in this Case

Again, Applicants note that the legal basis/rationale for the §103 rejection is not readily apparent. Nonetheless, Applicants respectfully submit that the prosecution record does not legally support a rejection of claims 19 – 23 under a theory of an obvious modification of the ‘294 application.

Although it is appropriate *in limited circumstances* for an Examiner to take official notice of facts not in the record or to rely on common knowledge without documentary evidence to support the conclusion, Applicants respectfully submit that this is NOT one of those limited circumstances. Official notice *unsupported by documentary evidence* should only be taken by the Examiner “where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-

known.” See MPEP §2144.03. As noted by the court in *In re Ahlert*, official notice without unsupported documentary evidence is ONLY appropriate where the facts taken to be well-known are “capable of such instant and unquestionable demonstration as to defy dispute.” 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970).

Applicants respectfully submit that attaching the straps to the bottom portion of the frame would not have been obvious to one of ordinary skill in the art at the time the invention was made. In fact, Applicants note that all commercial products prior to Applicants’ invention employed the straps on the top portion of the frame -- not the bottom portion. At the risk of redundancy, this is worth repeating. Prior to Applicants’ invention, not a single storage device product for attaching to a t-top on a boat used straps attached to the bottom portion of the frame. All prior art devices attached the straps to the top portion of the frame. Thus, Applicants note that, at least within this field of endeavor, the feature of attaching the straps to the bottom portion of the frame is certainly not an insubstantial difference capable of instant and unquestionable demonstration as to defy dispute.

Accordingly, Applicants respectfully request that documentary evidence be supplied to substantiate the alleged facts. In the event that documentary evidence is not provided to support a prima facie case of obviousness, Applicants respectfully request that claims 19 – 23 be allowed.

Therefore, in summary, Applicants respectfully assert that claims 19 – 23 are patentable under §103 regardless of the legal theory of obviousness based on the prior art of record. Accordingly, Applicants respectfully request that claims 19 – 23 be allowed.

CONCLUSION

For at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims 1 – 14 and 16 - 23 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (813) 229-4241.

Respectfully submitted,



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